



PATENT  
Attorney Docket No. 09700.0066-01000  
SAP Ref. No. 2003P00324 US01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: )  
Bjoern GOERKE et al. ) Group Art Unit: 2162  
Application No. 10/781,271 ) Examiner: Robert Stevens  
Filed: February 17, 2004 ) Confirmation No. 2046  
For: DEVELOPING AND USING USER )  
INTERFACES WITH VIEWS )

**Attention: Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, this is a Reply Brief to the Examiner's Answer mailed August 5, 2008, which has a two-month period for reply extending through October 6, 2008 (October 5 being a Sunday). This Reply Brief addresses the new points in the "Response to Argument" section of the Examiner's Answer. In addition, this Reply Brief addresses the "New Ground(s) of Rejection" also presented in the Examiner's Answer.

An **Argument** in reply to the Examiner's Answer follows on the next page of this paper.

## **ARGUMENT**

Claims 1-3, 5-24, and 28-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0046789 to Inanoria (hereinafter, "Inanoria") in view of U.S. Patent Application Publication No. 2003/0225829 to Pena et al. (hereinafter, "Pena"), the document entitled "Information Visualisation Using Composable Layouts and Visual Sets," authored by Tim Pattison et al. (hereinafter, "Pattison"), and the document entitled "Handling Multiple Domain Objects with Model-View-Controller," authored by Michael J. Mahemoff et al. (hereinafter, "Mahemoff"). In addition, in the Examiner's Answer, the Examiner introduced a new ground of rejection for claims 1-3 and 5-24 under 35 U.S.C. § 101.

Appellants respectfully traverse the rejections of claims under 35 U.S.C. §§ 101 and 103(a), and respectfully request the Board to reverse the Examiner's rejections of the claims 1-3, 5-24, and 28-31.

### **I. Rejection under 35 U.S.C. § 101**

In the Examiner's Answer, the Examiner introduced a new ground of rejection for claims 1-3 and 5-24 under 35 U.S.C. § 101, alleging that these claims are "directed to non-statutory subject matter." Examiner's Answer, p. 4. Specifically, the Examiner states that "[i]ndependent claims 1 and 16 are each directed to a 'computer program product . . . tangibly embodied in a computer-readable medium....'" Id. at p. 5. The Examiner quotes from page 14 of Appellants' Specification, alleging that the cited passage of Appellants' Specification "explicitly defines a computer program product as [ ] 'a computer program tangibly embodied in an information carrier, e.g., ... in a propagated signal, for execution by, or to control operation of ... a computer.'" Id.

(emphasis in original). According to the Examiner, “a computer readable-medium has been reasonably interpreted as encompassing a signal, or other non-statutory subject matter.” Id.

Appellants submit that the Examiner’s interpretation is unreasonable because there is no “explicit definition” of a computer program product in the specification and because the Examiner’s interpretation ignores the words “tangibly embodied” from claims 1 and 16. To begin, Appellants respectfully note that the cited portion of the Specification at page 14, lines 17-21 states:

“[t]he invention can be implemented as a computer program product, i.e., a computer program tangibly embodied in an information carrier, e.g., in a machine-readable storage device or in a propagated signal, for execution by, or to control the operation of, data processing apparatus, e.g., a programmable processor, a computer, or multiple computers.”

Thus, the specification contains two examples of an information carrier. The first example is “a machine-readable storage device,” and the second example is “a propagated signal.” Claims 1 and 16, however, recite “a computer-readable medium,” not an “information carrier.” Although the specification provides a signal as an example of one type of “information carrier,” it does not explicitly define the claimed “computer-readable medium” as encompassing a signal. The Examiner’s interpretation is unreasonable because it is not supported by the specification.

More specifically, the Examiner’s application of the disclosure to the claims is misplaced in that the independent claims 1 and 16 recite “[a] computer program product tangibly embodied in a computer-readable medium . . . .” The claims do not recite “a

computer program tangibly embodied in an information carrier,” as the Examiner has apparently concluded.

In addition, the Examiner’s interpretation is unreasonable because it ignores the words “tangibly embodied.” “Tangibly” means in a manner discernible to the touch; palpably. The American Heritage College Dictionary, 1385 (3d ed. Houghton Mifflin Co. 2000). A signal is not palpable or discernable to the touch. Thus, it is not reasonable to interpret a computer-readable medium that “tangibly” embodies a computer program product as encompassing a signal.

Moreover, the M.P.E.P. supports the position that the recited “computer-readable medium” is statutory subject matter. According to the M.P.E.P., “[w]hen functional descriptive material is recorded on some **computer-readable medium**, it becomes structurally and functionally interrelated to the medium and **will be statutory** in most cases since use of technology permits the function of the descriptive material to be realized.” M.P.E.P. § 2106.01 (emphasis added). “[F]unctional descriptive material’ consists of data structures and **computer programs** which impart functionality when employed as a computer component.” Id. (emphasis added).

Thus, the Examiner’s interpretation of Appellants’ claim language as allegedly being non-statutory is unreasonable. Appellants’ claims do not recite a “propagated signal,” nor does Appellants’ specification define “[a] computer program product tangibly embodied in a computer-readable medium” to include “a propagated signal.” Appellants’ independent claims 1 and 16 each recite “[a] computer program product tangibly embodied in a computer-readable medium . . . ” and this recitation falls squarely within the category of statutory computer-related subject matter. Accordingly,

Appellants respectfully request the Board to reverse the Examiner's rejection of claims 1-3 and 5-24 under 35 U.S.C. § 101.

**II. Rejection under 35 U.S.C. § 103(a)**

Appellants respectfully request that the Board reverse the Examiner's rejection of claims 1-3, 5-24, and 28-31 under 35 U.S.C. § 103(a) because the Examiner has not established a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). In view of the mischaracterizations of the cited references set forth in the Examiner's Answer and in the original rejections, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Examiner has failed to clearly articulate a reason why independent claims 1 and 16 would have been obvious to one of ordinary skill in view of the prior art.

In the Examiner's Answer, the Examiner appears to rely upon the following logic to support the combination of Inanoria, Pena, Pattison, and Mahemoff:

1) "[W]hat Inanoria teaches is directed to an improvement over the prior art that is centered around, inter alia, the choice of programming language used in the implementation of a GUI builder application" (Examiner's Answer, p. 19);

2) "[s]uch choices are design variables that are well within the grasp and understanding of those of ordinary skill in the art" (*id.*); and

3) "the references as a whole teach the claim language" (*id.* at pp. 22, 25, 26, and 28).

The Examiner's basic premise, however, is incorrect, and the Examiner's corresponding conclusions are unsupportable. That is, Inanoria is not "centered around . . . the choice of programming language," and the references as a whole do not disclose the claim recitations in a manner required by 35 U.S.C. § 103(a). Id. at p. 19. More specifically, Extended Model View Controller (XMVC), as disclosed by Inanoria, is not a programming language; it is a software architecture. Similarly, Model View Controller (MVC), as disclosed by Pena and Mahemoff, and Pattison's layout compositions trees are also software architectures. Each of these distinct software architectures have different functionality, and the Examiner has failed to show that one of skill in the art could have combined them in the proposed manner.

According to the M.P.E.P., there is a requirement to show that, when combining references, "one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yield[s] nothing more than predictable results to one of ordinary skill in the art." M.P.E.P. § 2143(A) (internal citations omitted) (emphasis added). Here, the Examiner has failed to demonstrate that the elements of an XMVC software architecture are combinable with selected elements of MVC or layout composition tree software architectures. Indeed, the Examiner casually suggests that these software architectures are merely "design variables that are well within the grasp and understanding of those of ordinary skill in the art." Examiner's Answer, p. 19. This statement is technologically unsound. The elements of a software architecture are not design variables; they are the foundational components in software engineering.

Indeed, the Examiner has steadfastly failed to articulate why the various combinations of Inanoria, Pena, Pattison, and Mahemoff would have been obvious and how the references could have been combined without changing their respective architectures. Instead, the Examiner's Answer merely indicates "[i]t would have been obvious . . . to apply the teachings of Pena for the benefit of Inanoria, because to do so allowed a system designer to implement a platform- and language-independent content delivery system and method." Examiner's Answer, p. 8.

A similar deficiency is found when the Examiner provides the rationale for "apply[ing] the teachings of Pattison for the benefit of Inanoria in view of Pena," alleging that "to do so allowed a user to simultaneously exploit the strengths of a number of information visualization techniques." Id. at p. 9. And, when discussing Mahemoff, the Examiner states that "to [apply the teachings of Mahemoff] provided a designer with a simple but effective way to develop user interface prototypes." Id. at p. 14.

Appellants note that "rejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142. Here, no evidence in the cited references teaches or suggests that the Examiner's proposed modification is obvious or contemplated by either Inanoria, Pena, Pattison, or Mahemoff, or that the combination of the different software architectures disclosed in these references would have yielded predictable results. Thus, the Examiner has not clearly articulated why the claimed invention would have been obvious, and a *prima facie* case of obviousness has not been established for independent claims 1 and 16.

Notwithstanding the apparent technological challenges to a combination of these references, the Examiner incorrectly asserts in the Examiner's Answer that "the

references as a whole teach the claim language.” Id. at pp. 22, 25, 26, and 28. First, if the references cannot be successfully combined, then the references “as a whole” cannot teach the claim language.

Moreover, as stated in the Appeal Brief, the Examiner’s piecemeal application of the cited references to the claims is unsupportable. For example, Inanoria cannot disclose “each view in the set of views comprising a layout of the one or more user interface elements selected from the set of user interface elements,” as alleged by the Examiner, if Inanoria does not first disclose “enabling a user to lay out one or more views for a user interface including allowing the user to select one or more user interface elements from a set of user interface elements for each of the one or more views,” as recited in claim 1.

As set forth in the Appeal Brief, neither Inanoria, nor Pena, nor Pattison, nor Mahemoff taken alone or in any reasonable combination, disclose or suggest at least the recitations of independent claim 1, and thus the Examiner has failed to properly ascertain the scope and content of the prior art, as well as the differences between the claimed invention and the prior art. For at least these reasons, the Examiner has not established a *prima facie* case of obviousness regarding independent claim 1. Accordingly, the rejection of independent claim 1 under 35 U.S.C. § 103(a) is improper, should be reversed, and the claim allowed. Claims 2, 3 and 5-15 are also nonobvious at least because of their dependence from nonobvious independent claim 1.

Independent claims 16 and 28-31, although of different scope, recite subject matter similar to that of independent claim 1. For at least the same reason as set forth above in connection with independent claim 1, the cited references cannot support a



rejection of claims 16 and 28-31 under 35 U.S.C. § 103(a), and the rejection of claims 16 and 28-31 should be allowable over Inanoria, Pena, Pattison, and Mahemoff should be reversed. Claims 17-24 are also nonobvious at least because of their dependence from nonobvious independent claim 16.

### **CONCLUSION**

For at least these reasons and the reasons given in Appellants' Appeal Brief filed on May 15, 2008, Appellants respectfully requests the Board to reverse the final rejection of claims 1-3, 5-24, and 28-31 under 35 U.S.C. §§ 101 and 103(a).

Please charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 2, 2008

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